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EXAMINER

SLOAN, NATHAN A

ART UNIT	PAPER NUMBER
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2614

13

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/879,353

Applicant(s)

TOGURI, YASUHIRO

Examiner

Nathan A Sloan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 6, 7, 8, and 16 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for general additional information comprising at least one of “contents ID, general purpose additional information ID, part covered by additional information, name covered by additional information, segment number, scene number, object number, and additional information classification,” does not reasonably provide enablement for general additional information comprising at least one of time or data of filming a video scene of said contents data, an explanation of a scene, or title to a background music. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. With reference to Figure 12, none of these elements are shown under the category 63 of “general purpose additional information,” rather, it appears some of these elements fall under contents information region 61.

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***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 5-7, and 16-17 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Itakura et al., U.S. Patent No. 6,351,745.

Itakura et al. teach a system used in a communication network that allows clients to access information internet over a broadband connection as well as receive messages such as advertisements. User preferences are stored in a user database and advertisements are sent to users based on their preferences. A billing system is also taught to charge the advertiser based on the advertisements displayed to the user.

With respect to claims 1, 6, and 16, Itakura teaches the claimed information processing apparatus. The claimed “first registration means for registering general additional information regarding said contents data” is met by Itakura’s means to store data and identifying information. In column 8, lines 1-11 Itakura teaches storing data which represents the location of the data requested. This information may also include, for example, a home page address (URL) of a store on the world wide web. Because applicant has claimed a plurality of types of “general additional information” in the alternative, the burden on the examiner is only to satisfy a single

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element. Therefore, the claimed “general purpose additional information ID” is met by storing in association an ID, such as the above noted URL. This is explicitly taught in column 8, lines 7-11. In this manner, Itakura meets the claimed first registration of “general information” regarding said contents data. The claimed “second registration of additional individual information...” is met by Itakura in the registering of client preferences in item S414 of figure 17. User information such as sex, marriage status, occupation, etc. are stored in the message user database 34 of figure 6. Itakura also teaches that a transmittal condition database 36 can record additional individual information regarding goods that the user has already shown interest in, claimed “on the basis of at least said contents data,” to ensure that suitable advertisements are sent according to user preferences in column 10, lines 48-58. As taught in column 10, lines 21-30, this database stores message URL’s that identify each message and the corresponding transmission conditions. By using the user information to find proper messages, the message URL’s are also “registered” for individual users based on preferences as “additional individual information,” as claimed. The claimed storage means for storing said first and second registration information are thus met by the message user database 34 and the transmittal condition database 36. The stored general additional information and additional individual information is extracted using a characteristics reader used to retrieve characteristics from the databases as taught in column 27, lines 48-49. If a user is inactive, messages including general and individual additional information are not sent. Rather, only when “a delivery request for contents data” is received will the message distribution apparatus search and extract required information (col. 15:13-42). The individual additional information “is extracted on the basis of user information comprising at least one of user status and user usage classification” by

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extracting based on user status, active or idle, and user characteristics, in order to accurately target active users.

Furthermore, the claimed generation means for generating individual data to be transmitted based on the general and individual additional information is met by the message distribution apparatus 39 of figure 1. Itakura teaches receiving a request for contents, followed by the reading of user preferences from said message user database 34 and transmittal condition database 36. Based on user preferences, messages as well as a URL relating to additional information are generated as taught in column 10, lines 31-58. The transmission means for transmitting said contents data, general additional information, and additional individual information is met by Itakura in column 11, lines 60-67 and column 12, lines 1-8. Itakura teaches an internet connection with known communication method and message distribution apparatus 39 for distributing said individual data as messages to a terminal 10 of figure 1. With respect to displaying said contents data, general additional information, and individual additional information *simultaneously*, examiner refers applicant to Figures 29 and 33. As seen in Figure 29 and 33 a contents data region 60 is shown, a "Location region" is shown for displaying the claimed "general additional information regarding said contents data," a message viewer window 62 exists to display claimed "individual additional information," which is retrieved as noted above using user database 34 and transmittal condition database. Examiner notes with reference to Figure 12, item 64 of applicant that the "additional information" region includes an "id link to other data," as taught by Itakura with Home Page button 64 that is an ID link to other data regarding the individual data.

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With respect to claim 2, the claimed means for recording charging information on the basis of individual data generated is met by Itakura in the message access log 37 as seen in figure 12. Itakura teaches recording information regarding the access of said individual information data in column 1, lines 9-21.

With respect to claim 5, the claimed updating charging information by updating "charges to at least an end user for use of said contents data and/or individual metadata on the basis of said generated metadata" is taught in col. 10:59+ through col.11: 8 by relieving a charge from a user based on a connection log. The connection log indicates what messages are recognized by a user and bills the message provider in order to relieve the user of their connection fee.

With respect to claim 7, the claimed recording medium wherein a program for controlling an information processing apparatus to deliver data over a network is taught by Itakura in the message manager 24. Itakura teaches message viewer software 76 of figure 3 to be installed on the terminal device in a recording medium in column 8, lines 43-67 and column 9, lines 1-3. Itakura further teaches that the recording medium can be a variety of devices such as RAM, DVD's, floppy disks, CD-ROM, tap media, semiconductor memory, etc in column 25, lines 5-24. The software in the terminal device is used to communicate with message manager 24 of figure 1 over the internet. The message manager is taught to send and receive messages with the terminal as well as access databases. In this manner the message manager meets the claimed program because it controls the processing of all limitations set forth and addressed in claim 6. With respect to "said contents data, general additional information, and individual additional information are simultaneously displayed on a display screen at said other apparatus," these features are taught as seen in Figures 29 and 34 and noted in response to claim 1.

With respect to claim 17, Itakura teaches delivering messages and additional information to users based on their viewing history, as well as charging message providers in response to the delivery of the messages. As noted above, Itakura teaches receiving a request for a message, followed by the reading of user preferences from said message user database 34 and transmittal condition database 36. Based on user preferences, characteristics including status, and usage history as seen in Figures 7, 8, and 9, claimed user status and classification, the messages suitable for individual viewers are generated. This general purpose additional information is displayed in the message viewer window 62 and as well as a URL link through home page button 64. Although the specific term “metadata” is not used, the generation of individual metadata from general additional information and extracted additional information is taught. Examiner notes that applicant defines metadata as additional information that describes audio and video data on page 1, lines 18-21. This information is taken as commonly defined in the industry to include information such as name, size, data type, length, location, ownership, associations, and a number of other factors that describe contents data. As seen in Figures 11 and 12, a record is formed with information describing the extracted information including a note as to whether material requests are made. This information is taught to be used to “update charging information on the basis of said generated individual metadata,” in column 10, lines 20-38. The claimed transmission of contents data and individual metadata, information describing the audio video contents data, is met as noted above.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4, 8, 10, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itakura as applied to claims 1, 2, and 5-7 above, and further in view of Baji et al., U.S. Patent No. 5,027,400.

With respect to claims 3, 4, 10, 12, and 14 all of the limitations that are reflected in claim 1 as addressed above. Itakura does not teach the first registration means registering information by splitting the contents of data per segment, scene, or object. Furthermore, Itakura teaches the second registration means registering individual additional information with URL addresses but not split per segment, scene, or object as claimed. Baji teaches a cable distribution network used to transmit regular programming as well as commercials, claimed additional information, in a television broadcast. Baji explicitly teaches the transferring of desired program and advertisement to the main controller 106 of the head end in column 4, lines 13-17. The main control program then controls the integration of the advertisements with the regular programming, splitting the regular programming up as in claim 3 of applicant and inserting commercial or advertisement scenes as in claim 4 of applicant. The table and method for controlling this process is shown in figure 10 and taught in column 7, lines 46-65. Examiner notes that it is well known in the industry to split up television programs, whether viewed over

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conventional television or via Internet broadcast, up into scenes with commercials show in between. Furthermore, Itakura teaches in column 9, lines 10-13 that the message viewer may display a new message every predetermined time interval, and the simultaneous display of this message as noted in response to claim 1. Baji similarly teaches splitting a television program with registered commercials at predetermined time intervals as seen in Figures 5A-5P, which splits the program per segment or scene as claimed. It clearly would have been obvious for one skilled in the art at the time to modify the simultaneous displaying of contents data and additional advertising information taught by Itakura by the data stream splitting techniques of Baji in order to integrate advertisements with the regularly viewed content.

With respect to claim 8, Itakura teaches the first apparatus as addressed in response to claim 1 above. Although Itakura teaches receiving and processing a request for data to be transmitted, Itakura does not teach a *second apparatus* having delivery request means so as to transfer said contents data to said first apparatus with means for *integrating* said contents data and said individual data supplied from the first apparatus. Baji teaches a main control unit 106 for controlling the access of contents data and additional individual data. Baji further teaches a second information apparatus the terminal control unit 113 of figure 1 to be used in conjunction with a delivery request. The commercials may be integrated into the regular contents data by storing commercials in a buffer on the terminal control unit and then integrating them into the regular content data in column 8, lines 30-48. In this manner, Baji teaches a delivery request for contents data by the main control unit, claimed first apparatus, and output means in the terminal unit, claimed second apparatus, for integrating the contents data and individual data. It would have been obvious for one skilled in the art at the time to modify the targeted advertisement

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apparatus of Itakura with the second apparatus of in order to integrate advertisements with regularly viewed content for the user.

7. Claims 9, 11, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itakura et al. (6,351,745) and Baji (5,027,400), and further in view of Kitsukawa et al. (6,282,713).

With respect to claims 9, 11, 13, and 15 neither Itakura nor Baji explicitly teach splitting registration per object appearing within said contents data. Examiner notes that the use of “hot spots” is well known in the art, and that these systems would read on many of the limitations of claim 1. Hot spots are used to allow the viewer to obtain additional information regarding items in a display. A display is split per object based on items, claimed additional information, with additional individual information consisting of a URL link that provides additional information about the item appearing in within the display. To these means, Kitsukawa et al. (6,282,713) teach an electronic advertising system utilizing hot spots to link users to additional information regarding displayed products. As seen in Figure 5, items containing additional information are separated per object and URL information, claimed individual additional information, is registered for each item. As seen in Figure 4, item 410, a user may select an item, claimed “request,” and as taught in column 7, lines 34-40 the full advertisement or web link may be displayed simultaneously with the regularly playing programming using well known picture in picture techniques. It would have been obvious for one skilled in the art at the time of the invention to further modify the techniques taught by Itakura and Baji by splitting additional information per object as taught by Kitsukawa in order to provide additional information relating to multiple items displayed in a program that the user may have interest in.

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Goldman (2003/0135853) teaches a system and method of inserting advertisements based on user profile information.


Hendricks et al. (2003/0145323) teach a targeted advertising system using television viewer information with database storage of general and individual information as seen with reference to Figure 10 and taught throughout the specification.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan A Sloan whose telephone number is (703)305-8143. The examiner can normally be reached on Mon-Fri 7:30am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703)305-4795. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4700.

NAS

  
JOHN MILLER  
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